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Date: June 7, 2005

Re: UNITED STATES Patent Application No. 10/024,544
For: **BODY FLUID ABSORBENT WEARING ARTICLE**
Inventor (s): Masashi NAKASHITA
Our Reference: 2038-282

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**As requested by Examiner Karin Reichle, attached is the Decision on
Petition mailed March 10, 2005 to be scanned into the PTO record.**

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Lowe, Hauptman, Gilman & Berner

In re Application of	:	DECISION ON PETITION
Masashi Nakashita	:	UNDER 37 CFR 1.144 TO
Serial No. : 10/024,544	:	REVIEW RESTRICTION
Filed : December 21, 2001	:	REQUIREMENT
For : Body Fluid Absorbent Wearing Article	:	

This is a decision on the petition under 37 CFR § 1.144 filed November 23, 2004, requesting review of the restriction requirement between inventions I and II as set forth in the Office action mailed April 19, 2004. Petitioner further requests to have the finality of the Office action mailed August 23, 2004 withdrawn. There is no fee for this petition.

BACKGROUND

In an Office action mailed April 19, 2004, the examiner required a restriction between three groups of claims indicating that groups I and III are related as combination and subcombination, Groups II and III are also so related, and that Groups II and I are related as combination and subcombination.

In a response filed May 19, 2004 applicant elected Group I and traversed the restriction requirement only as it pertained to Groups I and II.

In an Office action mailed August 23, 2004, the examiner considered applicants traversal, found it non-persuasive, and made the restriction requirement final. The claims of Groups II and III were withdrawn from consideration. The examiner also rejected the claims of Group I and made the Office action final.

On November 23, 2004 the instant petition and an amendment were filed.

DISCUSSION

At the outset, it is stated that the following discussion will be limited as it pertains to Groups I and II only, as the traversal was limited to these two groups.

Section 806.05(a) of the MPEP, Combination and Subcombination or Element, sets forth the difference between a combination and a subcombination. It states that "(a) combination is an organization of which a subcombination or element is a part".

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Section 806.05(c) of the MPEP, Criteria of Distinctness for Combination, Subcombination, or Element of a Combination, sets forth that in order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated, and specifies that it must be shown that, as claimed: (a) the combination does not require the particulars of the subcombination as claimed for patentability; and (b) that the subcombination has utility either by itself or in other and different relations. When these factors cannot be shown, such inventions are not distinct and, therefore, restriction between the two inventions is not proper.

In setting forth the restriction requirement, the examiner indicated that Group I, included claims 1-5 and characterized it as being a subcombination, and that Group II included claims 6-15 and characterized it as being a combination. To show distinctness, the examiner indicated that "the combination as claimed does not require the particulars of the subcombination as claimed because the Group II claims do not require the features of compressive restorative elasticity, a first subpanel having a flat portion, and a flat second subpanel and these features in combination with specific density or fiber weight percentages or superabsorbent weight percentages as set forth in the Group I claims."

Petitioner asserts that Groups II and I are not related as combination and subcombination because they are both drawn to body fluid absorbent wearing articles (applicant's response filed May 19, 2004). Further, petitioner reiterates in the instant petition that, for example, claim 6 (the representative independent claim of Group II, the "combination") is broader than claim 1 (the representative independent claim of Group I, the "subcombination") in all aspects and therefore cannot be a "combination" as a combination claim must be narrower in at least one aspect than the corresponding "subcombination" claim as by including an additional element.

A thorough review has been conducted of the entire application in order to determine if petitioner's arguments have merit. This review has revealed that petitioner is correct in his views. A careful comparison of the language found in claims 6 and 1, and keeping in mind the definitions of combination and subcombination set forth in section 806.05(a) of the MPEP, reveals that claim 6 cannot be characterized as being a combination claim relative to claim 1, as set forth by the examiner. Every element that is recited in claim 6 is found in claim 1. The preambles are identical in both claims as are the first three elements (the topsheet, backsheet and the liquid-absorbent panel). It is in the details of the panel where the differences between the two claims lie. However, every detail of the panel recited in combination claim 6 is found in the subcombination claim 1. Thus, since every element of claim 6, is found in claim 1, claim 6 cannot be characterized as a combination claim relative to claim 1 and therefore, the restriction requirement set forth in the Office action mailed April 19, 2004 is improper as Groups II and I are not related as combination and subcombination. As the two groups of claims identified above are not related as combination and subcombination, there is no need to delve into whether the criteria of distinctness and the reasons for insisting on restriction set forth in section 806.05(c) of the MPEP have been satisfied or not.

It is noted for the record that, assuming *arguendo*, had the characterizations of the claims been reversed, that is, Group I identified as the combination and Group II as the subcombination, restriction between the two would still have been considered improper, as the two-way distinctness test could not have been


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satisfied as the particulars or details of the subcombination as claimed are found in the combination as indicated above.

DECISION

Applicant's petition for review and reversal of the final decision to maintain the restriction requirement is **GRANTED** as is the request to have the finality of the Office action mailed August 23, 2004 withdrawn. Upon the mailing of this decision, the application will be returned to the examiner for consideration of all the pending claims in the application, along with the amendment submitted with the petition, which is responsive to the Office action of August 23, 2004.


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